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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/756,788

Applicant(s)  
Michael C. SCROGGIE et al.

Examiner  
Stephen M. Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9-3-02
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 32-58 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5,899 6) ☐ Other:

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. Examiner objects to the tremendous volume of references. Applicants have submitted more than 300 references which confuses the issue of patentability over the prior art. Examiner considers relevant information as to the patentability of the claimed invention may be buried under the thousands of pages of prior art references submitted by the applicants before a prior art search can be performed conducted by the Office. Applicants have not offered assistance to the Office by explaining the patentability of the claimed invention in light of the tremendous volume of references. It is requested that the applicant highlight the most relevant references for the Office per MPEP 2004.

### ***Requirements for Information***

2. 37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

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(iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

3. Examiner requires copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result and identification of what is being improved. Patents or printed publication information submission is required particularly for the claimed subject matter relating to the claimed features beginning with the recitations “means for delivering purchase incentives,” “means for delivering e-mail notices,” “transmitting incentives via an e-mail

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post office,” “transmitting consumers a notice,” “means for informing the consumer of new incentives,” and “formatting an e-mail message for subsequent coupon printing.”

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 58 is rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed maintaining, generating, and formatting contain recitations of descriptive material that cannot exhibit any functional interrelationship with the way in which computing process are performed and does not constitute a statutory process, machine, manufacture or composition of matter under 35 USC 101. Also those steps can be performed mentally without interaction of any physical structure or process. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

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***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 32-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources; a consumer purchase history database based on consumer online shopping activity; a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site are not enabled by the specification, because the specification does not discuss these system and method features such that one skilled in the art would be reasonably conveyed of inventor possession of the claimed invention. The specification merely recites vague language and general concepts but not the claimed details by the applicants. Since claims 33-37, 39-40, 45-49, 51-53, and 55-56 depend upon claim 32, 38, 44, 50, and 54 which recite the independently claimed non-enabling new matter features, those claims are also rejected as being non-enabling new matter from the independent parent claim. In order to

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consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 32-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources; a consumer purchase history database based on consumer online shopping activity; a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the specification does not provide an antecedent basis for those features. Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the specification such that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 33-37, 39-40, 45-49, 51-53, and 55-56 depend upon claim 32, 38, 44, 50, and 54 which recite the independently claimed indefinite feature, those claims are also rejected as being indefinite from the independent parent claim. In

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order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

10. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

11. Claims 32, 33, 38, 39, 44, 45, and 57 are rejected under 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). Those claims contain means for language which is not construed means-plus-function language under the rubric of reasonable interpretation, because the specification does not provide a clear limit of patentability. Those claimed means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation.



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***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 32-58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldhaber et al. (US 5,794,210), Manasse (US 5,802,497), Huberman (US 5,826,244), Jovicic et al. (US 5,855,007) or Day et al. (US 5,857,175) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barnett et al. (US 6,321,208).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 32-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method and system of:

a web site for providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer online shopping activating;

a consumer database which can identify consumers by their addresses, wherein said

consumer database is connected to said website so as to receive consumer data from said web site; and any one of

means for delivering purchasing incentives or web site visit notices to consumers;

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means for delivering notices to purchase a specific manufacturer's product;

transmitting purchase incentives or web site visit notices via a post office; and

means for or a method informing of new incentives or printing coupons. Examiner also has personal knowledge of consumer profile basis, purchase history database either by an independently administered or cooperative site, and where purchase history includes data based on past purchasing activity. The claimed web site for providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store, web site or kiosk and viewed discounted products from a sales catalog. The claimed consumer purchase history database based on consumer online shopping activating occurs when the examiner became a member of Team Performance which is a frequent buyer program and submitted demographic data. The claimed consumer database which can identify consumers by their addresses, wherein said consumer database is connected to said website so as to receive consumer data from said web site occurs when examiner submitted data to associate the PerformanceBike web site to receiving shopping information. The claimed steps including means for delivering purchasing incentives or web site visit notices to consumers, means for delivering notices to purchase a specific manufacturer's product, transmitting purchase incentives or web site visit notices via a post office, and means for or a method informing of new incentives or printing coupons were administered by PerformanceBike through sale mailings which included coupons of products available either at the retail outlet or web site. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of

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applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the claimed e-mail notification. It would have been obvious to one skilled in the art to provide the claimed e-mail notification since e-mail is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art). The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities through electronic mail mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention.

### ***Double Patenting***

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


18. Claims 32-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-39 of U.S. Patent No. 6,014,634 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim transmitting/receiving customer information over a network ('469 patent) is an obvious variation of the application claimed e-mail, because the patented claim personal information transmission data over a network ('634 patent) is an obvious variation of the application claimed e-mail, and because the patented claim of transmitting e-mail purchase incentive because in all three cases, both perform the same function in the same manner with the same result.

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*Conclusion*

19. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

<b>After-final</b>	<b>(703) 872-9327</b>
<b>Official</b>	<b>(703) 872-9326</b>
<b>Non-Official/Draft</b>	<b>(703) 872-9325</b>

  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg

January 13, 2003